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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,224	09/14/2000	Eugene J. Alexander	STAN-144/04US	3054

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IMAGING THERAPEUTICS, INC.  
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SAN JOSE, CA 95110-2731

EXAMINER

JUNG, WILLIAM C

ART UNIT PAPER NUMBER

3737

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

✓

<b>Office Action Summary</b>	<b>Application No.</b> 09/662,224	<b>Applicant(s)</b> ALEXANDER ET AL.	
	<b>Examiner</b> William Jung	<b>Art Unit</b> 3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 94-108 and 169-199 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 94,96,102-108, 169,171,177-184,186 and 192-199 is/are rejected.
- 7) ☒ Claim(s) 95,97-101,170,172-176,185, and 187-191 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed April 13, 2005 have been fully considered but they are not persuasive.

Examiner respectfully disagrees with the applicant after further consideration of the response and accompanying amendment. The inclusion of three-dimension geometry of the joint is already been established in Paul et al. Regarding response page 66, second paragraph, the applicant argues that Paul et al do not disclose electronically evaluating image to obtain information about the three dimensional geometry of the joint. However, the applicant's own argument in first paragraph admits that the Paul et al disclose diagnosing diseases by quantifying signal intensities of pixels of a MR images extending across a depth of the articulate cartilage. The quantifying intensities of pixels is defined as image process where images are electronical data. Therefore, the Paul et al clearly anticipate electrical evaluation of image. In addition, the quantification of the images extending across a depth defines as depth of the image data where image data is 2D. Therefore, the depth is clearly anticipatory of 3D image data. The basis of argument for 103 rejection on claims 96 , 103-105, and 108 is same as above.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 94, 102, 106, 107, 169, 177, 181, 182, 184, 192, 196, 197, and 199 are rejected under 35 U.S.C. 102(b) as being anticipated by *Paul et al* (US 5,320,102).

Paul et al anticipate all claimed features in claims 94, 102, 106, 107, 169, 177, 181, 182, 184, 192, 196, and 197. Paul et al disclose MRI imaging method obtain three-dimensional image of joint and bone where the images include healthy or normal and diseased cartilage tissue and evaluating the images about geometry such as location and size of the healthy bone and/or cartilage to assess the disease (col. 3, line 57 – col. 4, line 39; col. 8, lines 11-61). Diagnosing the disease or damage state of the bone or cartilages dictates the treatment or therapy method (col. 1, lines 37-47).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 96, 171, and 186 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Paul et al* as applied to claim 94, 169, and 184 above, and further in view of *Robinson* (US 5,291,401).

Paul et al substantially disclose all claimed features in claim 96. However, Paul et al do not disclose transferring image data from one location to another for image processing and analysis such as teleradiology. Robinson teaches that the diagnostic data such as radiological images such as Paul et al's MR images of bone can be transfer to remote location for processing an analysis. Therefore, it would have been obvious to one having an ordinary skill in the art at

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the time the invention was made to apply Robinson's teleradiology to Paul et al's medical image diagnostic method.

6. Claims 103-105, 108, 178-180, 183, 193-195, and 198 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Paul et al* as applied to claims 94, 106, 107, 169, 181, 182, 184, 196, and 197 above, and further in view of *Hunziker* (US 5,206,023).

Paul et al substantially disclose all claimed features in claims 103-105 and 108. However, Paul et al do not disclose specific method in which the treatment is carried out. Hunziker teaches that the bone diseases/damages treatment includes chondrocytes, autografting by cell adhesion promoting factor with no-human material such as chemotactic agents, artificial implantation such as composite matrix (col. 4, line 5 – col. 6, line 30). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to apply Hunziker's treatment method to Paul et al's diagnostic method of bone and/or cartilage diseases/damages to assess the method of treatment.

#### ***Allowable Subject Matter***

7. Claims 95 and 97-101 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Jung, Ph.D. whose telephone number is 571-272-4739. The examiner can normally be reached on Mon-Fri 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WJS

June 16, 2005

  
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